

REMARKS

In this office action the Examiner rejected claims 1-20 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated, "The term 'likely to be unfamiliar to an average reader' in claim 1 is indefinite, because it is not clear how one would determine what an 'average reader' would be', nor is it clear how the likeliness of such a reader being familiar with a given word would be known. The terms 'generally' in claim 8 and 'substantially about' in claims 9 and 20 are indefinite, because it appears in each instance that applicant is attempting to claim some range of shape and size that falls within the scope of the claimed invention, without clearly specifying the range."

With respect to this rejection, Applicant has amended claim 1 to remove the phrase "likely to be unfamiliar to an average reader". On the other hand, Applicant must respectfully disagree that claims 8,9 and 20 are unclear. The term "generally" in claim 8 is frequently used in claims to prevent a party from just modifying the shape or size slightly to avoid literal infringement. Similarly the phrase "substantially about" when referring the size being about 4½ by 8½ inches is to prevent someone from modifying the size slightly to avoid literal infringement. These phrases are commonly found in claims. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-20 under 35 U.S.C. 112,

second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Further in the office action the Examiner rejected claims 1-3, 7-9, 11, 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Goodman. To support the rejection the Examiner stated, "Goodman discloses in Figures 1 and 4 and in column 3, line 35 to column 4, line 25 an apparatus comprising a rectangular substrate 26 having a predetermined size and configuration, wherein information pertaining to a particular book is printed on the substrate. While Goodman does not explicitly disclose that definitions of words are provided on the substrate, Goodman does disclose that various types of information, including descriptions of characters and answers to questions, are provided. Words and definitions are very analogous to characters and their descriptions, and would have been an obvious variation to one of ordinary skill in the art for the purpose of providing a reference guide to selected words. The phrase 'for marking a page in a predetermined book' is functional language, which describes the intended purpose of the device rather than providing further structural limitation, and thus is not deemed to have patentable weight. The substrate of Goodman is physically capable of being used to mark a book. With respect to claims 2 and 3, while the material used to form the substrate is not explicitly disclosed, Official Notice is taken that it is well known to use paper for sheets such as that of the Goodman device. With respect to claim 7,

Official Notice is taken that in providing definitions of words, it is well known too utilize synonyms. Such a feature would have been obvious for the purpose of enabling a user to easily and quickly determine the definition of a word. With respect to claim 9, while the size of the sheet is not explicitly disclosed, Official Notice is taken that reference sheets are provided in many different sizes. The specific size claimed would have been an obvious variation. With respect to claim 11, Official Notice is taken that standard print is, well, standard for sheets containing printed matter. With respect to claim 13, the word key logo does not appear to have a specific function apart from trademarking or decorative purposes, and as such is an aesthetic choice of design. With respect to claim 14, Goodman discloses in Figure 4 that the Title of the book is provided on the substrate. Modification to include the author's name would have been obvious for the purpose of providing additional detail regarding the book."

Applicant must disagree with the Examiner's interpretation of Goodman with respect to the present invention. Goodman teaches, "According to the present invention in its broadest aspect, there is provided a reference list for use with a book, comprising a sheet having inscribed thereon information related to the contents of the book, which information is arranged in the same order as the corresponding parts of the book, and masking means overlying the information and adapted to be removed by the reader as required so as to provide a reference index in which only information relating to parts of the book already read is revealed."

(Column 1, lines 45-54). (Underlining is for emphasis.)

The present invention provides a mini-dictionary in which difficult words found in the book are defined generally in the context of which the words are used in the book. The words are listed in alphabetical order and the apparatus is open to the reader from the very beginning. There is no masking means overlying the information in the present invention.

Further, Goodman teaches "Referring now to the drawings, there is shown in FIGS. 1 to 3 a holder of a progressive index according to a first embodiment of the invention, consisting of a three-layer structure comprising a bottom layer 2, an intermediate layer 4 and a top layer 6. The three layers are made of relatively thin, transparent plastic material such as polyethylene, P.V.C. or the like. In the embodiment as illustrated the bottom layer 2 and the top layer 6 consist of a single, folded piece of material. However, the holder can be made of three separate pieces.

In manufacturing the holder, the first step consists of thermally "stitching" the intermediate layer 4 and the top layer 6 together by means of horizontal welding seams 8 that define the width of the thus produced pockets 10 into which fit slidingly the masking strips 12 shown ghosted-in FIG. 1 and in FIG. 3, and the vertical seam 14 which delimits the depth of the pockets 10 so that even when the strips are inserted into the pockets 10 as far as they will go, i.e. right up to the seam 14, their free end 16 will slightly project beyond the edge 18 of the pocket 10 to facilitate manipulation.

As a final step, the bottom layer 2 is joined to the already joined intermediate and top layers 4 and 6. In the illustrated embodiment this is effected by two additional welding seams, a vertical seam 20 and a horizontal seam 22 that also delimits the lowermost pocket 10.

If the bottom layer 2 and the top layer 6 are made of separate pieces, an additional horizontal seam 22 is of course required at the top edge of the holder. The seams 20 and 22 have now defined a compartment 24 into which slidingly fits a sheet 26 on which there is printed the information relevant to the book, for example the list of characters appearing in the book." (Column 3, line 35 to Column 4, line 1).

The present invention has no pockets nor are there any "weldable" or "stitched" seams in the present invention. The present invention provides one sheet, which may be folded or as a simple one page sheet, with words and definitions presented on at least one side of the sheet. The size of the sheet is such that it can be used as a bookmark without being unwieldy and this also keeps the apparatus handy for use when needed.

The apparatus of Goodman provides for basically five layers of material. Three layers of plastic form the holder while there is a sheet of material inserted in the pocket and then there are masking strips which cover the sheet with information on it that are to be removed as the book is read. This would present a rather clumsy bookmark but probably anything, regardless of how large it

is or how awkward it is, could be used as a bookmark in the broadest sense even if it is not practical.

The prior art of Goodman does not teach or even suggest an apparatus as that as defined in the claims of the present invention. It is only in hindsight that the apparatus as taught by Goodman can be compared to the apparatus that is provided in the present invention. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-3, 7-9, 11, 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Goodman.

The Examiner rejected claims 4, 5 and 16-20 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar. The Examiner stated, "Goodman discloses all of the limitations of claims 4 and 5 with the exception of the lamination. Providing lamination to printed matter including reference lists is well known, as disclosed for example in column 6, lines 15-18 of Renegar. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose of enhancing the durability of the sheet. With respect to claim 5, it is well known, when laminating an article, to use plastic. Goodman further discloses or suggests all of the limitations of claims 16-20 with the exception of the folding creases. Providing folding creases to printed matter including reference lists is well known, as disclosed for example in Figures 4-9 of Renegar. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose of

enhancing the durability of the sheet. At least 8 surfaces are shown in Figure 6 (the four shown, and the four on the rear side.)"

Applicant does not understand why the Examiner feels that "it would be obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose of enhancing the durability of the sheet". There is no need for lamination of the Goodman apparatus since the apparatus as taught by Goodman is formed from a thin transparent material such as polyethylene and, thus, since the apparatus is encased in polyethylene laminating this apparatus would be a costly unnecessary step which would not provide any additional durability to the sheet since polyethylene is probably more durable than lamination.

Further, if the sheet itself, as taught by Goodman, were laminated it would be difficult to fit the laminated sheet into the pocket formed in the polyethylene holder. Again, this would be totally unnecessary since the sheet as taught by Goodman is protected by sheets of polyethylene.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claims 4, 5 and 16-20 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar.

The Examiner rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar, and further in view of Finkleston. The Examiner stated, "Goodman as viewed in combination with Renegar discloses all of the limitations of the claim with the exception of the magnifying feature. Finkleston

discloses in column 5, lines 10-59 a laminated article comprising an integral magnifying lens. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman as viewed in combination with Renegar by providing a magnifying feature for the purpose making the substrate easier to read."

Finkelston teaches "The subject invention is directed to a financial transaction card such as a credit card or the like which incorporates an integral magnifying lens. Use of the card of the subject invention automatically places a magnifying lens at the disposal of the user, whereby he may immediately verify a financial transaction at the point-of-sale without first locating a magnifying glass or taking the time and effort to put on reading glasses." The magnifier of Finkelston is basically a magnifying lens placed in a credit card which the user may place over a sheet with sale information on it so as to be better able to read the numbers or the terms of an agreement. This is quite different than having magnification in the plastic laminate which is covering the apparatus. In the present invention the magnification is there all the time and is part of the apparatus and is not moveable but is in the laminate covering the words and definitions so as to make them appear larger and easier to read by the user. The teaching of Finkelston would be no different than having a magnifying glass available instead of having the magnifier imbedded in a credit card.

Applicant has previously discussed the teaching of Goodman in view of the teaching of Renegar and since Finkelston does not teach

a magnification means similar to that of the present invention Applicant respectfully requests that the Examiner withdraw the rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar, and further in view of Finkleston.

The Examiner also rejected claim 10 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Batjuk. The Examiner stated, "Goodman discloses all of the limitations of the claim with the exception of the bold print. Batjuk discloses in the Figure an apparatus comprising a substrate having words and definitions, where the words are printed in boldface, and the definitions are provided in standard print. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing boldfaced words for the purpose of making them easier to distinguish from the definitions."

Applicant has discussed previously that Goodman neither teaches nor even suggests an apparatus as that claimed in the present invention. The teaching of Batjuk does not affect the fact that the present invention is different from that as taught by Goodman; therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Batjuk.

Claim 12 was rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Marshall. The Examiner stated, "Goodman discloses all of the limitations of the claim with the exception of the words being in alphabetical order. Marshall discloses in Figure 1 an apparatus comprising a substrate

for use with a book having letters and sounds, where the letters are provided in alphabetical order. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing words in alphabetical order for the purpose of making them easier to find on the substrate."

Marshall discloses in Figure 1 and Figure 2B words that are not in alphabetical order. The items in Figure 2A, which the Examiner referred to as Figure 1, are the common vowels and they are normally put in the order of a,e,i,o and u. Marshall also lists the word consonants further down on the sheet after he had listed the word(s) short vowels and c is alphabetically earlier in the alphabet than s. This does indicate that Marshall is not necessarily teaching words being placed in alphabetical order. Marshall is teaching sounds or word pronunciations and not definitions.

Since it was previously discussed that Goodman does not teach the present invention and the addition of Marshall does not alter the difference between Goodman and the present invention, Applicant respectfully requests that the Examiner withdraw the rejection of claim 12 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Marshall.

The Examiner rejected claim 15 under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Leon. The Examiner stated, "Goodman discloses all of the limitations of the claim with the exception of the magnifying slide. Leon discloses in Figure 1 and 6 and in column 2, lines 61-64 an apparatus comprising a

substrate having printed matter thereon, further comprising a magnifying slide 22. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a magnifying slide for the purpose of making the substrate easier to read."

The present invention provides a magnifying slide affixed to the substrate. The substrate is where the words and definitions of the present invention are displayed. In the invention of Goodman the information is disposed on a sheet which is encased in a pocket formed between two layers of polyethylene. It would be difficult to provide a magnifier which could slide over the sheet with information as taught by Goodman when the sheet is in a pocket and which further is covered by masking strips which are uncovered individually. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claim 15 under 35 U.S.C. 1 03(a) as being unpatentable over Goodman in view of Leon.

Applicant makes note that it required 6 different prior art references for the Examiner to reject the claims of the present invention which would indicate that the invention is not obvious with regard to the referenced prior art.

In view of the amendment to claim 1 and the discussion supra it is believed that claims 1-20 are patentable. Therefore, Applicant believes that this application is now in condition for allowance and such allowance by the Examiner is respectfully requested.

In the event the Examiner has further difficulties with the examination and/or allowance of the application, the Examiner is invited to contact the undersigned agent for applicant by telephone at (412) 380-0725, if necessary, to resolve any remaining questions or issues by interview and/or Examiner's Amendment as to any matter.

Respectfully submitted,
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